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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,083	10/31/2003	Wesley Scott Ashton	ASHTON0009	9725
7590		09/07/2005	EXAMINER	
Wesley Scott Ashton		RODRIGUEZ, RUTH C		
8549 Black Foot Court		ART UNIT		
Lorton, VA 22079		PAPER NUMBER		
		3677		

DATE MAILED: 09/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/697,083

Applicant(s)

ASHTON, WESLEY SCOTT

Examiner

Ruth C. Rodriguez

Art Unit

3677

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-31 is/are rejected.
- 7) ☒ Claim(s) 32-35 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 21 and 31 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 30 of U.S. Patent No. 6,675,613 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the current application are broader than the claims of the U.S. Patent No. 6,675,613 B2 since the method does not require that the substance be dissolved over time in the wearer's mouth with the saliva.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 21, 22, 28, 29 and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Katz (US 6,326,022).

A method of dispensing a substance into a mouth wherein the substance is selected from a group consisting of a breath freshener, a medication and a flavoring agent (C. 3, L. 58-66). The method comprises the steps of: (a) providing a mouth and tongue stud including a means for dispensing a substance formed in a portion of the stud (C. 3, L. 58-61). The means of dispensing a substance contains the substance (C. 3, L. 58-66); (b) mounting the stud in a fistula of a wearer's mouth (Figs. 1-22); and (c) dispensing the substance into the wearer's mouth (C. 3, L. 66 and 67 and C. 4, L. 1).

The substance comprises a breath freshener (C. 3, L. 63-66).

The substance is disposed into the wearer's mouth by dissolving the substance over time in the wearer's saliva (C. 3, L. 66 and 67 and C. 4, L. 1).

Regarding claim 31 having similar limitations to claim 21, the rejection of claim 21 serves to reject claim 31 since it has similar limitations and Katz discloses that the substance is a medication (C. 3, L. 58-66).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 23-27 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katz

Katz discloses a method for dispensing a substance into a mouth that has all the steps disclosed in paragraph 4 for the rejection of claims 21 and 22. Katz also discloses the substance can be a medicine. However, Katz fails to disclose the substance can comprises a flavoring agent or a flavoring agent mixed with the breath freshener or a medicine mixed with a breath freshener or the medicine mixed with a flavoring agent or medicine mixed with a breath freshener and a flavoring agent. However, it would have been obvious to one having ordinary skill in the art at the time of applicant's invention that the substance could comprise a flavoring agent or a flavoring agent mixed with the breath freshener or a medicine mixed with a breath freshener or the medicine mixed with a flavoring agent or medicine mixed with a breath freshener and a flavoring agent since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. Especially, since the

use of medication with flavoring agents and/or breath freshener is well known in the art in order to provide a pleasant flavor since the substance is being used in the mouth.

Allowable Subject Matter

7. Claims 32-35 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

8. Applicant's arguments filed 20 June 2005 have been fully considered but they are not persuasive.

9. The first argument presented by the Applicant for claims 21 and 31 is that the Katz patent fails to disclose a mouth and tongue stud in accordance with the Applicant's invention. This argument fails to persuade because the claim fails to provide any details for describing the mouth and tongue stud. Therefore, any structure that can be used in the wearer's mouth that is capable of dispensing a substance or medication can be considered the tongue and mouth stud until the claim provides more details for the stud regardless of whether the stud creates an annoyance to the wearer's tongue or not.

10. The Applicant also argues that the opening between two teeth cannot be considered a fistula. To support this position the Applicant provided a definition from

Stedman's medical dictionary. The Examiner also fails to be persuaded by this argument. The disclosure only recites that the stud can be mounted in a fistula formed in the wearer's lip. The disclosure and the claims fail to provide any definition in accordance with the definition provided by the Applicant. Until this definition is incorporated to the claims and the disclosure, the term fistula will be given its broader interpretation that is an abnormal opening as defined by Webster Meridian dictionary and the abnormal opening provided between two teeth as defined by Katz can be considered a fistula.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Warren, Jr. (US 3,754,332), Lariccia et al. (US 3,943,928), Cournut et al. (US 4,020,558), Harris et al. (US 4,551,329), Garay et al. (US 4,861,268), Stanley et al. (US 5,855,908), Denny et al. (US 6,047,209), Katz (US 6,326,022 B1) and Levy et al. (US 6,592,860) are cited to show state of the art with respect to devices used to deliver a medication or other substance into a wearer's mouth.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ruth C Rodriguez whose telephone number is (571) 272-7070. The examiner can normally be reached on M-F 07:15 - 15:45.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on (571) 272-7075.

Submissions of your responses by facsimile transmission are encouraged. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-6640.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ruth C. Rodriguez
Patent Examiner
Art Unit 3677

rcr
September 6, 2005


ROBERT J. SANDY
PRIMARY EXAMINER